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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/041,128	01/07/2002	Clifford A. Pickover	YOR9200100372US1	3989

48175 7590 04/03/2006

BMT/IBM
FIVE ELM STREET
NEW CANAAN, CT 06840

EXAMINER	
RHODE JR, ROBERT E	

ART UNIT	PAPER NUMBER
3625	

DATE MAILED: 04/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/041,128	PICKOVER ET AL.	
	Examiner	Art Unit	
	Rob Rhode	3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 January 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1, 2, 4 – 5, 20, 21, 29 and 58* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1, 2, 4 – 5, 20, 21, 29 and 58* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

Applicant amendment of 1-23-06 amended claims 1 and 20 as well as traversed rejections of Claims 1, 2, 4 – 5, 20, 21, 29 and 58.

Currently, claims 1, 2, 4 – 5, 20, 21, 29 and 58 are pending.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 2, 4, 5, 20, 21 and 58 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 - 36 of U.S. Patent No. 6,658,415 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims address an authority that provides approval for selecting and associating an item or content.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 4 – 5, 20, 21, 29 and 58 are rejected under 35 U.S.C. 102(e) as being anticipated by Chow (US 6,850,899 B1).

Regarding claim 1 and related claim 58, Chow teaches a method for electronic shopping, comprising: receiving a rule; receiving an instruction from a consumer to associate an item with an electronic shopping cart; automatically determining, in response to the instruction, and based on the rule that the item is not allowed to be associated with the electronic shopping cart; and automatically presenting an indication to the consumer, the indication indicating that item is not allowed to be associated with t electronic shopping cart (see at least Abstract, Col 1, lines 21 – 30, Col 2, lines 39 – 54 and Col 4, lines 4 – 12).

Regarding claim 2, Chow teaches a method, wherein the determination is based on rules (Abstract).

Regarding claim 4, Chow teaches a method according, wherein the rules are based at least in part on a price of the item (Col 4, lines 7 – 8).

Regarding claim 5, Chow teaches a method, wherein the rules comprise a rule specifying that a price of all items in the shopping cart may not exceed a specified total price (Col 4, lines 8 – 10).

Regarding claim 20, the recitations that "wherein the determining step comprises: determining whether approval of the association has been received from at least one of: a law enforcement agency; a government entity; and a service bureau ", such recitation is given little patentable weight because it imparts no structural or functional specificity which serves to patentably distinguish the instant invention from the other "approval" already disclosed by Chow.

Regarding claim 21, Chow teaches a method, wherein the step of determining whether approval of the association has been received is not performed for all items (Col 8 – 10).

Regarding claim 29, Chow teaches a method, wherein the item comprises at least one of merchandise, stocks, bonds, services and knowledge (Col 4, lines 4 – 9).

Response to Arguments

Applicant's arguments filed 1-23-06 have been fully considered but they are not persuasive.

Applicant argues that Chow does not teach or suggest receiving a rule.

As noted above, Chow would teach one of ordinary skill that a rule is received (Abstract).

Applicant argues that Chow does not teach that a shopper is automatically presented with an indication that a product is not allowed to associated with a shopping cart.

As noted above, Chow would teach one of ordinary skill that a shopper is automatically presented with an indication that a product is not allowed to associated with a shopping cart (Col 2, lines 49 – 54). For example and in broad and reasonable interpretation, the shopper who has selected an item is presented with a completely different item is a clear indication that item they originally selected cannot be associated with the cart.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rob Rhode whose telephone number is 571.272.6761. The examiner can normally be reached Monday thru Friday 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Fadok can be reached on 571.272.6755.

Any response to this action should be mailed to:

Commissioner for Patents

P.O. Box 1450

Alexandria, Va. 22313-1450

or faxed to:

571-273-8300 [Official communications; including
After Final communications labeled
"Box AF"]

For general questions the receptionist can be reached at

571.272.3600

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). RER

Jeffrey A. Smith
Primary Examiner